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APPLICATION NO. 09/022,357	FILING DATE 02/11/98	FIRST NAMED INVENTOR FELDRUES	ATTORNEY DOCKET NO. 10032-PJJ
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HM12/0303

EXAMINER RAZGUNAS, A
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ART UNIT 1611	PAPER NUMBER 5
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DATE MAILED: 03/03/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner of Patents and Trademarks

See the enclosed Notice of the Patent Drawing Review, PTO-540.  
The enclosed drawing is being submitted to the Examiner.  
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For information, the following is being submitted to the Examiner:  
☒ A claim for foreign priority under 35 U.S.C. 119(a) is being submitted.  
☒ Some of the CERTIFIED copies of the priority documents have been received.  
☐ received in Application No. (Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).  
Certified copies not received: \_\_\_\_\_  
A claim for domestic priority under 35 U.S.C. 119(a) is being submitted.

Attaching to:  
☒ References Cited, PTO-892  
☐ Disclosure Statement(s), PTO 1449, Page No(s) \_\_\_\_\_  
☐ Summary, PTO-810  
☐ Notice of Unpublished Patent Drawing Review, PTO-540  
☐ Notice of Informal Patent Application, PTO-152

LOCAL OFFICE ACTION ON THE PTO-152 FORM

# Office Action Summary

Application No.  
09/022,337

Applicant(s)  
Feldhues et al.

Examiner  
Ann Razgunas

Group Art Unit  
1611



☒ Responsive to communication(s) filed on Feb 11, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to diaminostilbenes, classified in class 544, subclass 197.
- II. Claim 12, drawn to a process for brightening polyamide, cellulose or paper, classified in class 8, subclass 931.

Inventions I and II are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Richard Henderson on February 23, 1999 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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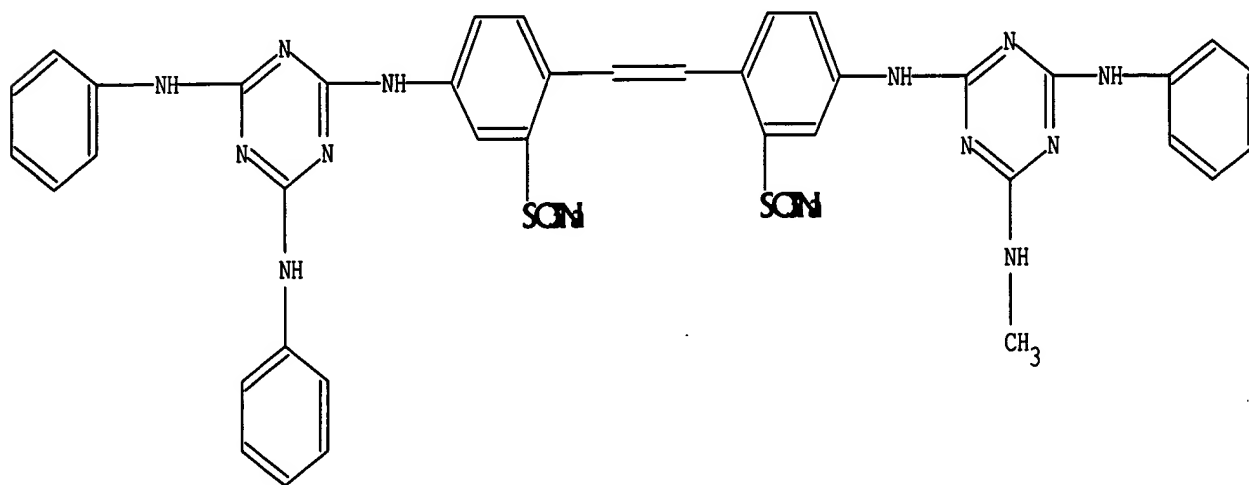
named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

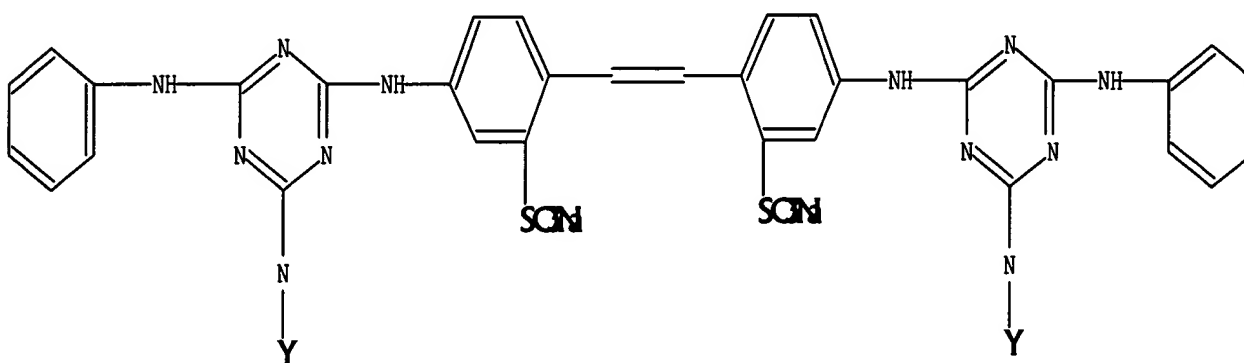
Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel et al. (US 3,177,207), Frishkorn et al. (US 3,655,574), or Fringeli et al. (US 3,895,009). Siegel et al. teaches the process of making the compound with the following structure in example 1 columns 3-4:



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In the third condensation step aniline is added to the chlorinated starting material formed from previous reaction steps with the following reaction conditions of: an aqueous reaction mixture (line 31 column 4); a pH of 7 maintained with sodium carbonate (lines 25-26 column 4); and a reaction temperature of 98 degrees Centigrade (line 35 column 4).

Frishkorn et al. teaches the process of making compounds with the following structure in Ia and Ib of examples 1 and 2 columns 3-6:

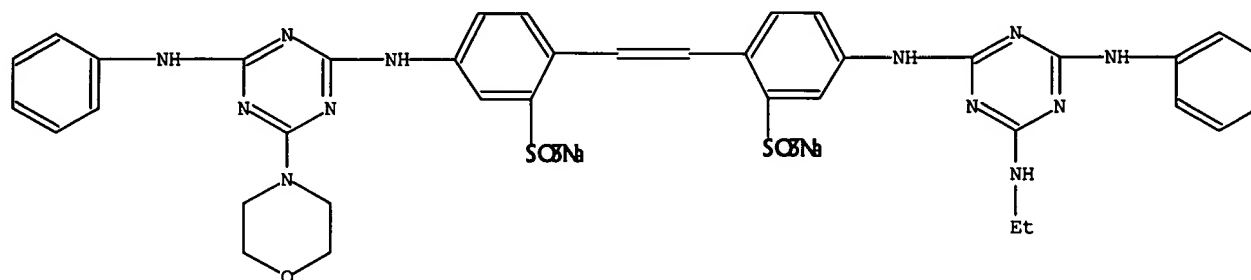


Y = ethanolamine; morpholine

In the third condensation step ethanolamine is added to the chlorinated starting material formed from previous reaction steps with the following reaction conditions of: an aqueous reaction mixture (line 68 column 3); a pH of 5-6 is maintained with sodium carbonate (lines 7-8 column 4); and a reaction temperature of 97-100 degrees Centigrade (line 9 column 4). Although a mixture of components is formed this way Frishkorn et al. states in column 2 line 66 that single components can also be formed in this way.

Fringeli et al. teaches the process for making the following compounds in example 5 column 9:

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In the second condensation step, ethanolamine and morpholine are added to the chlorinated starting material formed from previous reaction steps with the following reaction conditions of: an aqueous reaction mixture (line 40 column 9); a pH of 10.5 is maintained with sodium hydroxide (lines 44-45 column 9); and a reaction temperature of 85-90 degrees Centigrade (line 42 column 9) from the previous temperature of the starting material of 35-40 degrees Centigrade (line 34 column 9).

Selection of specific conditions from within the processes of the prior art is held to optimization by routine experimentation. In the absence of a showing of unexpected results, no patentable significance is seen in the present selection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Razgunas whose telephone number is (703) 308-4732.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Ann Razgunas

February 26, 1999

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1611